

REMARKS

Review and reconsideration of the Final Office Action of June 4, 2004, is respectfully requested in view of the above amendments and the following remarks.

Applicant has amended the claims to overcome the Examiner's rejection. Care has been taken to ensure that no new matter is added to the claims. Support for the amendment to Claim 1 is found in the Specification and canceled Claim 4.

Present Invention

The present invention teaches a process for the structuring of a paper poster or paper photograph, for the plastic reproduction, true to the original, of oil paintings.

Office Action

Turning now to the Office Action in greater detail, the paragraphing of the Examiner is adopted.

Paragraphs 1 -5 (Claim Rejections - 35 USC § 103) and 6

The Examiner rejects Claims 1-3, 5, 7, 8, and 10 under 35 U.S.C. 103(a) as being unpatentable over Falk (US Patent No. 3,964,946) in view of Lang et al. '063 (US Patent No. 5,182,063) and Baratto (US Patent No. 5,721,041).

Applicant notes that this rejection is almost identical to the previous 103 rejection made by the Examiner in the First Office Action dated December 18, 2003.

Further, the Examiner stated that she has fully considered the arguments filed March 22, 2004, but finds them not persuasive.

Applicant traverses the rejection and conclusions of the Examiner.

In response, Claim 1 has been amended to include the limitation of Claim 4. The Examiner had rejected Claim 4 as being obvious in view of the combination of U.S. Patent No. 3,964,946 to Falk, U.S. Patent No. 5,182,063 to Lang et al., and U.S. Patent No. 5,721,041 to Baratto and any one of U.S. Patent No. 3,856,592 to Giorgi, U.S. Patent No. 4,971,743 to Lang, and U.S. Patent No. 154,576.

In the outstanding action, the Examiner stated that the arguments presented in the previous response were not found to be persuasive. The Examiner considered them as being directed to the obviousness rejection only in that they were directed to what was taught in view of the claims. I believe that the Examiner missed the intent of the argument, which was that no one skilled in the art would have sought to combine the references. This response is directed to the Examiner's motivation to combine these references.

The Examiner appears to have simply sought out references, each of the primary references (the first three cited) are introduced to teach one of the steps of the present invention. The references applied to Claim 4 are only being used to teach the use of the elastic mat (now introduced in amended claim 1). However, the Examiner seems to be approaching this from the perspective of seeing the complete invention and then trying to work backwards, whereas an obviousness rejection should be based on a number of similar references that could be easily combined.

Specifically, in ascertaining the differences between the prior art and the claims at issue (the second factual inquiry of Graham v. John Deere, it is essential to view the claims at issue as "the invention as a whole", as required by §103 and "without the benefit of hindsight vision afforded by the claimed invention". Hodosh v. Block Drug Co., Inc., 5, 229 USPQ 182 n. 5 (Fed. Cir. 1986).

Applicant submits that the cited references would never be combined.

Falk '946 is directed to giving the surface texture of canvas to a print, and does so by laminating paper to canvas. The canvas in the '946 reference is then analogous to both the matrix and the canvas of the present application. Claim 1 requires removing the paper from the matrix, which is clearly not the intent of the '946 reference. That being said, the Examiner may be correct in the assertion that it teaches the step of adhering a canvas on to the back surface of the paper copy (which forms a laminate).

Lang '063 is cited to teach the step of placing the paper copy with image side down onto a matrix and cold pressing. I submit that from the starting point of Falk, the only reason that one would be drawn to Lang '063 is if they already knew that the end point was amended Claim 1. Lang teaches away from the use of laminates (in column 12, at lines 29-32, Lang et al. states "...the printed image is not placed on a carrier laminated to another substrate.") Additionally, Lang uses a two sided press, whose plates have mating features (a bump in one is matched by an indentation in the other. No one using a two sided press would be drawn to combine the teachings of Lang '063

with the elasticized mat required in amended Claim 1, as the mat negates the effect of the patterning on one of the two plates.

Baratto '041 is introduced to show the fixing of the laminate to the matrix. Baratto is directed to the field of creating surface texture in thermoplastic laminates. Nothing in Baratto indicates that these techniques could be used with non-thermoplastic laminates. The Examiner's contention is that this simply indicates that it is well known to fix the image print to the matrix, and that you could easily combine this with Falk and Lang '063 to get the matter of Claim 1. The fixing of the image to the matrix in Baratto is done to allow a heating of the thermoplastic film and then a vacuuming of the print into the matrix. It is tenuous at best that there is an analogous relationship between the laminate of amended Claim 1 and the thermoplastic film of Baratto, but the lack of a pressing operation indicates that the Examiner has simply attempted to find a reference that teaches the one step.

The remaining references were cited to show that the use of the elasticized mat is known. However, Lang '063 teaches away from their use, as indicated above.

The Examiner has simply identified a few key steps in the present invention, and searched for references that teach each step individually. There is nothing in the references that indicates that they could be combined, and in fact, there are several differences that show that they probably couldn't be used together. Lang '063 uses a technique that would never be combined with an elasticized mat and specifically teaches against the use of laminates, whereas Baratto would not be referred to by someone looking to work with paper based laminates. The Examiner is reminded that In re Fritch, 972 F.2d

1260, 1265-66, 23 U.S.P.Q. 2d 1780 (Fed. Cir. 1992); it was held: "A proposed modification [is] inappropriate for an obviousness inquiry when the modification render[s] the prior art reference inoperable for its intended purpose."

The Examiner has combined these references by looking back after seeing the invention, instead of standing at the point of the prior art and looking to combine references that share commonalities (it should be noted that no two references are relied upon to teach the same step in amended Claim 1, which would at least create some overlap; instead we have a distinct mosaic and no indication of why anyone skilled in the art would consider combining the references).

Lastly, a §103 rejection based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, is not proper and the *prima facie* case of obviousness cannot be properly made. In short, there would be no technological motivation for engaging in the modification or change. To the contrary, there would be a disincentive. In re Gordon 221 USPQ 1125 (Fed. Cir 1984).

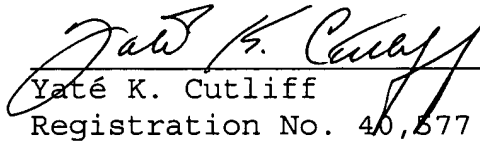
Withdrawal of the rejection is respectfully requested.

U.S. Application No. 10/067,108
AMENDMENT B

Attorney Docket No.: 3648.031

All claims are now in condition for allowance. Favorable consideration and early issuance of the Notice of Allowance are respectfully requested. Should further issues remain prior to allowance, the Examiner is respectfully requested to contact the undersigned at the indicated telephone number.

Respectfully submitted,


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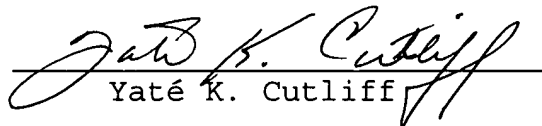
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Date: **September 7, 2004**

CERTIFICATE OF MAILING AND AUTHORIZATION TO CHARGE

I hereby certify that the foregoing AMENDMENT B for U.S. Application No. 10/067,108 filed February 4, 2002, was deposited in first class U.S. mail, postage prepaid, addressed: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on **September 7, 2004**.

The Commissioner is hereby authorized to charge any additional fees, which may be required at any time during the prosecution of this application without specific authorization, or credit any overpayment, to Deposit Account No. 16-0877.


Yaté K. Cutliff